

REMARKS

Claims 1 through 14, 17 through 23, and 38 through 46 are pending. Claims 15, 16, and 24 through 37 are canceled without prejudice. Applicants have the right to file a divisional application to recapture the subject matter of claims 15, 16, and 24 through 37.

Applicant appreciates the thoroughness of the Examiner's office action. Reconsideration is requested in light of the amendments above and the remarks below.

In the Specification & Drawings

Amendments to the specification have been made to correct minor spelling/grammatical errors, and to clarify the item numbers in Figures 5 and 6 that were duplicative to references in earlier portions of the specification. Figures 5 and 6 have been amended to correspond to changes made in the specification. A replacement sheet is attached.

Section 102 Issues

Claims 1 through 6, and 8 through 14 are rejected under 35 U.S.C. §102(b) as allegedly anticipated by United States Patent No. 5,652,008 to Heiligman (the '008 patent).

Applicant traverse the rejection and respectfully submits that the '008 patent does not anticipate the present invention. The identical invention must be shown in as complete detail as is contained in the... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Figure 1 of the '008 patent shows water filtration device 10 suspended across the opening 12 of container 14 using support member 89 that has a plurality of leg members 90 that extend radially from the support member (as shown in Figure 2). The plurality of leg members 90 sit on a rim of container 14 to suspend water filtration device 10 across the opening of the container. Water filtration device 10 is not supported upon a wall member of container 14, but rather is supported across the rim of container 14 using the plurality of leg members 90. Clearly, water filtration device 10 is not in contact with nor

supported upon the wall member of the container or any compartment upon which water filtration device 10 can be used. Since the '008 patent does not contain all elements and limitations found in independent claim 1, it cannot be anticipatory.

Dependent claims 2 through 6, and 8 through 14 are also not anticipated by the '008 patent since they contain all the elements and limitations of independent claim 1, all of which are not found in the '008 patent.

Thus, Applicants respectfully request withdrawal of the rejection and allowance of claims 1 through 6, and 8 through 14.

Claim 7 is rejected under 35 U.S.C. §102(b) as allegedly anticipated by, or in the alternative, as allegedly obvious, under 35 U.S.C. §103(a), over United States Patent No. 5,652,008 to Heiligman.

Claim 7 depends from independent claim 1 and should be read to include all the elements and limitations of independent claim 1. Since the '008 patent does not contain all elements and limitations found in independent claim 1, it cannot anticipate dependent claim 7. Thus, Applicants respectfully request withdrawal of the rejection and allowance of claim 7.

With respect to the Examiner's alternative rejection under 35 U.S.C. §103(a), Applicants traverse the rejection and respectfully submit that if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). There is no indication that claim 1 is rejected under 35 U.S.C. §103, and the '008 patent does not teach or suggest the invention of independent claim 1. Since claim 1 is nonobvious, dependent claim 7 is nonobvious as well.

Furthermore, the Examiner has not established a *prima facie* case of obviousness. There is no support in the law or the Manual of Patent Examining Procedure (MPEP) for the Examiner's assertion that mutilating the apparatus of the prior art reference, by snapping, cutting off, or otherwise removing the handle 72 shown in the '008 patent, renders obvious the claimed invention. Such a non-conforming use does not support a finding of obviousness.

Applicants respectfully request withdrawal of the rejection and allowance of claim 7. Should the Examiner maintain this rejection, Applicants request that the Examiner point to explicit support shown in the MPEP or the Code of Federal Regulations for the rejection pursuant to MPEP 2144.03.

Even if, *in arguendo*, a *prima facie* case does exist, Applicants respectfully submit that the cited reference teaches away from the claimed invention. *See* MPEP 2144.05. The prior art must provide a motivation or reason for the worker in the art, without the benefit of [Applicants'] specification, to make the necessary changes in the reference device. *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984). All drawings in the '008 patent show a fixed handle on the water filtration device. Furthermore, the '008 patent states that handle 72 is preferably molded, therefore permanently attached, to the center of the first planar horizontal mesh. *See* column 3, lines 14 to 22. There is nothing in the '008 patent that teaches or suggests the releasably attached handle of claim 7 or a modification thereof. Thus, Applicants respectfully request that all rejections of claim 7 be withdrawn and claim 7 pass to issuance.

Section 103 Issues

Claims 17 through 23 and 38 through 45 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over the combined teachings of United States Patent Nos. 5,652,008 and 5,393,548 (the '548 patent), both to Heiligman.

Applicants traverse the rejection for the following reasons. The Examiner asserts that it would have been obvious to modify the device of the '008 patent within the compartment of a coffee maker in order to more securely position the filter. Alternatively, the Examiner asserts that it would have been obvious to modify the device of the '548 patent by incorporating the legs in order to more securely position the filter within the compartment. Either assertion is without merit. Should the device of the '008 patent be positioned in the brew basket of the coffee maker, it would render the coffee maker inoperable, or at the very least dangerous, because the device would sit on the rim of the brew basket

inhibiting the coffee maker from closing properly or altering the position of the brew basket. In either situation, hot water would be spewing from the coffee maker creating a hazardous condition. Thus, the combination of the '008 patent and the '548 patent would effectively teach away from the present invention. As there is no basis or motivation in the cited prior art for combining the '008 patent and the '548 patent, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness, and the rejection should be withdrawn. Claims 17 through 23 and 38 through 45 should pass to issuance.

Claim 46 appears to be rejected under 35 U.S.C. §103 as allegedly being obvious in view of what is conventionally known in the art as modified by the '008 patent and the '548 patent. Applicants point out that the filter media used in the water filtration devices of the '008 patent and the '548 patent are both loose granular carbon or other granular materials. There is nothing to teach or suggest that a fused media is contemplated. Thus, claim 46 contains allowable subject matter and should pass to issuance.

Section 112 Issues

Claims 1 through 14 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to point out and distinctly claim the subject matter that applicant regards as the invention.

Applicants have amended claim 1 such that the compartment and ingredients are placed in the preamble portion of the claim and are only referred to in the claim body, thereby more clearly indicating that the compartment and ingredients exist to flesh out the environment of the claimed invention, and are not part of the claimed invention. Therefore, given the amendment to claim 1, Applicants submit that the rejection under §112, second paragraph is obviated and the rejection be withdrawn.

Applicants respectfully request reconsideration and allowance of claims 1 through 14, 17 through 23, and 38 through 46. A petition for a one (1) month extension of time is hereby requested such that this response is considered timely filed. Please debit or credit Deposit Account No. 502371 with any fees filed.

associated with this response. Should there be any concerns or issues associated with the instant application that may be addressed by telephone, the Examiner is encouraged to call the undersigned at 203.799.9000 x277.

Respectfully submitted,



Date: 20 March 2003

Shirley S. Ma
Registration No. 44,216

KX Industries, L.P.
269 S. Lambert Road
Orange, CT 06477
203-799-9000 x277

CERTIFICATE OF MAILING

I hereby certify that the foregoing document is being deposited with the U.S. Postal Service as first class mail addressed to the Assistant Commissioner of Patents, U.S. Patent & Trademark Office, Washington, DC 20231.

Shirley S. Ma
Name

20 March 2003
Date


Signature



VERSION WITH MARKINGS TO SHOW CHANGES MADE

Marked Up Paragraphs:

Please replace the paragraph on page 1, lines 9 through 12, with the following:

The present invention relates to a device capable of removing contaminants in a liquid, and a method and system for such a device. More particularly, this invention relates to a device used in a brewed beverage maker for removing contaminants in a liquid, and a method and system for such a device.

Please replace the paragraph on page 7, line 15 to page 8, line 3, with the following:

Wall 12 is preferably provided with a plurality of outwardly protruding extensions 18. Although, extensions 18 may extend from top rim 14 of wall 12 or at substantially any position between top rim 14 and a bottom rim 13, extensions 18 are preferably disposed in close proximity to bottom rim 13. Extensions 18 protrude outwardly a sufficient length to enable contact with brew basket 50 (see Fig. 4). It is preferable that extensions 18 are flexibly attached to wall 12 so that extensions 18 may move relative to wall 12. By flexibly connecting extensions 18 to wall 12, ~~exten~~extensions 18 may pivot relative to wall 12 until to the top of device 10 sits below the top rim 51 of beverage brewing basket 50, while remaining above the brewing ingredients. The flexing area of extensions 18 are preferably designed to allow for maximum flexing with minimum force, without fracturing. Extensions 18 may be initially set perpendicular or at an angle relative to wall 12. Extensions 18 are preferably formed of the same or similar material as wall 12. Furthermore, extensions 18 are preferably integrally formed with wall 12.

Please replace the paragraph on page 9, line 12 to page 10, line 1, with the following:

As shown in FIG. 5, filter medium 20 is most preferably a composite structure formed by an adsorbent supporting web substrate 70-71 having a surface 72-82 fused to a mixture of adsorbent particles 74-84 and binder particles 76. Adsorbent particles 74-84 are coalesced or fused together by binder particles 76, which are interposed therebetween. Also, some of the binder particles are fused to surface 7282. The composite structure is preferably obtained according to the method described in United States Patent No. 5,792,513, issued on August 11, 1998, which is incorporated in its entirety herein by reference. As described therein, a mixture of adsorbent particles 74-84 and binder particles 76 is applied to part or all of surface 7282, thereby producing a loose powder coating on surface 7282. The loose powder coating is heated to at least the Vicat softening temperature of binder particles 76, but below the melting temperature of adsorbent supporting substrate 70-71 and adsorbent particles 7484. Pressure is applied to web substrate 70-71 to cause the softened binder particles to coalesce, or fuse together, adsorbent particles 7484, as well as adhere adsorbent particles 74-84 to adsorbent supporting web substrate 7071.

Please replace the paragraph on page 10, line 3 to line 8, with the following:

Filtration medium 20 comprises an adsorbent supporting web substrate 70-71 that may be formed preferably using non-woven fibrous materials, such as the spun-bonded polyesters and polyolefins. Woven substrates may also be used. Furthermore, adsorbent supporting web substrate 70-71 may optionally be formed using cellulosic materials, such as paper, or a combination of cellulosic and thermoplastic fibers.

Please replace the paragraph on page 10, line 14 to page 11, line 3, with the following:

Referring to FIG. 6, a filter medium 20 can be modified to include an overlying web substrate 78-88, which could be formed of materials similar to supporting web substrate 70-71. Overlying web substrate 78-88 has a surface 80 facing coated surface 72-82 of adsorbent supporting web substrate 70-71. Adsorbent particles 74-84 may also be adhered to surface 80 of overlying web substrate 78-88 by binder particles 76. The fusing of adsorbent particles 74-84, supporting substrate 70-71, and overlying web substrate 78-88 can be accomplished according to the disclosure in United States Patent No. 5,792,513. Essentially, after applying the mixture of adsorbent and binder particles to the surface of adsorbent supporting web substrate 70 to produce a powder coating covering at least a portion thereof, as described above, overlying web substrate 78-88 is applied over both adsorbent supporting web substrate 70-71 and the powder coating thereon. Heat and pressure is applied to adsorbent supporting web substrate 70-71 and overlying web substrate 78-88 to soften binder particles 76. The softened binder particles coalesce, or fuse together, adsorbent particles 74-84, as well as adhere adsorbent particles 74-84 to web substrates 70-71, 78-88.

Please replace the paragraph on page 11, lines 5 to 16, with the following:

Both the adsorbent supporting web substrate 70-71 and the overlying web substrate 78-88 may provide supplemental particulate filtration. For example, filter medium 52-20 can reduce certain waterborne oocysts when web substrate 70-71 and overlying web substrate 78-88 are composed of a fine hydrophilic particulate filter medium, potentially combined with adsorbents such as activated carbon and heavy metal adsorbing zeolites. Co-pending United States Patent Application Serial No. 09/140,924, filed August 27, 1998, and assigned to the assignee hereof describes a low flow resistance composite filter medium for capturing at least 99.95 percent of particulates of a size in the 3 to 4 micron range, such as oocysts, and dissolved chemical contaminants from a fluid that

can be used as a high flow rate filter medium in the present invention. The subject matter of that application incorporated herein by reference in its entirety.

Marked Up Claims:

1. (Amended) A device for use with a compartment having a wall member, said compartment housing beverage ingredients, said device comprising:

means for removing contaminants from a liquid, said means for removing ~~adapted to be~~being releasably supported upon asaid wall member of asaid compartment ~~having beverage ingredients~~, wherein said removing means is separated from ~~the~~said ingredients.